



NOV 20 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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LACKENBACH SIEGEL
MARZULLO ARONSON & GREENSPAN
ONE CHASE ROAD
SCARDALE, NY 10583

In re Application of :
KOJIMA : DECISION ON
Application No.: 09/856,393 :
PCT No.: PCT/JP99/05257 : PETITION
Int. Filing Date: 27 September 1999 :
Priority Date: None : UNDER 37 CFR 1.181,
Attorney's Docket No.: P-0105 \$:
For: PRONUNCIATION EVALUATION : 1.182 & 1.183
SYSTEM :

This is in response to applicant's "Petition under 37 CFR 1.181, 1.182 and 1.183 with Supporting Declaration" filed in the United States Patent and Trademark Office (USPTO) on 11 July 2001, requesting the above referenced application be converted from a national stage application filed under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a).

BACKGROUND

On 22 May 2001, applicant submitted U.S. national application papers including a Transmittal Letter (Form PTO-1390) requesting processing as a national stage application under 35 U.S.C. 371. Applicant also filed a purported English translation of the international application. The first sentence of the specification submitted indicated the following: "This is a Continuation Application of PCT Application No. PCT/JP99/05257 filed September 27, 1999, which was not published under PCT Article 21(2) in English." The papers were treated as a national stage filing under 35 U.S.C. 371 and assigned application no. 09/856,393.

On 11 July 2001, applicant filed the instant petition requesting that the application be converted from a national stage application under 35 U.S.C. 371 to a U.S. application filed under U.S.C. 111(a).

DISCUSSION

As explained at Section 1893.03(a) of the Manual of Patent Examining Procedure (MPEP), any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13

entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

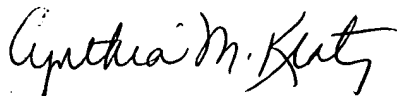
On 22 May 2001, applicant filed the basic national fee for entry into the national stage in the USPTO and a transmittal letter identifying the application as a filing under 35 U.S.C. 371. However, a claim of continuation status of PCT/JP99/05257 is made in the accompanying specification, where the following statement appears at page 1 thereof: "This is a Continuation Application of PCT Application No. PCT/JP99/05257 filed September 27, 1999, which was not published under PCT Article 21(2) in English." Applicant's benefit claim under 35 U.S.C. 120 to the international application made at the top of the first page of his specification is inconsistent with a filing to treat the present application as the national stage of PCT/JP99/05257 under 35 U.S.C. 371.

In view of the above noted conflicting instructions, the papers are considered as having been filed under 35 U.S.C. 111(a).

CONCLUSION

For the reasons above, the petition to treat the present application as a filing under 35 U.S.C. 111(a) is **GRANTED**. The "Notification of Acceptance" (Form PCT/DO/EO/903) mailed 05 July 2001 is hereby **VACATED**.

The application is being forwarded for the National Stage Processing Branch of the Office of PCT Operations to remove the Article 20 papers communicated from the International Bureau to the United States of America. The application will then be forwarded to the Office of Initial Patent Examination for processing the present application as a filing under 35 U.S.C. 111(a) and having a filing date of 22 May 2001.



Cynthia M. Kratz
Attorney Advisor
PCT Legal Office



Boris Milef
Legal Examiner
PCT Legal Office

CMK/BM:cmk
Telephone: (703) 306-5467

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the New U.S. Patent Application of

Akitoshi KOJIMA

Examiner:

Serial No.: 09/856,393

Art Unit:

Filed: May 22, 2001

Docket: P-0105 S

For: Pronunciation Judgment System

Commissioner of Patents: Attn - PCT Petitions Branch - By Fax (703 308 6459) 10 pages)
Washington, D.C. 20231

RECEIVED

JUL 23 2001

Technology Center 2600

*PLEASE
deliver to Examiner
BORIS MILEF*PETITION UNDER 37 CFR §§1.181, 1.182 AND 1.183
WITH SUPPORTING DECLARATION

SIR:

RECEIVED

11 JUL 2001

Legal Staff
International Division

For the reasons set forth below, this petition is being submitted to:

I. Convert the filing of the above-identified application from a filing under 35 U.S.C. §371 to one filed under 35 U.S.C. §111;

II. To identify the subject application as a continuation application, pursuant to 35 U.S.C. §120, of International Patent Application (filed in Japan) No. PCT/JP99/05257, filed on September 27, 1999;

III. Request that a credit be issued to our account no. 10-0100 in the amount of \$150.00, which is the difference between the amount of \$900.00, which has been paid as a filing fee, and \$750.00, the amount that should have been paid (\$710.00 plus \$40.00 assignment recordation fee) had this application originally been filed under 35 U.S.C. §111.

The facts in support of this Petition are as follows:

(1) The application was received from an associate firm in Japan on May 21, 2001. The

New U.S. Patent Application of Akitoshi KOJIMA
Serial No.: 09/856,393
Docket: P-0105 S

associate firm requested that we file the application by May 25, 2001.

(2) The Japanese associate in question had sent a number of patent applications to our firm for filing. In each case, we were given priority materials either in the form of copies of or reference to a Japanese national application, or in the form of copies of documents previously filed in a PCT application based on a Japanese national application.

(3) In the first case (Japanese national filing), we were asked to file a U.S. national application deriving priority from the Japanese application. In the second case, we were asked to file a National Phase application in the U.S. based on the PCT patent application.

(4) When we received the filing materials for the above-captioned U.S. filing, we were given copies of documents previously filed in the PCT, as well a translation of a filing in Japanese into the English language. This English translation we considered, in our U.S. filing materials, to be "A English-language translation of the International Application," and checked the appropriate box.

(5) In the "cover" or "order" letter received from our Japanese associate, a copy of which is attached, the enclosures were identified. Included were "specification and claims," "formal drawings," "informal drawings," "Declaration & power of attorney," "Inventors' Assignment/consent," and a "Copy of int'l search report/cited art" as well as a "First page of Intern'l Publication."

(6) On the basis of the prior filings for this Japanese associate, and on the basis of instructions that the application be filed "on the basis of the above-identified PCT application" ("SPECIFIC REMARKS," no. (1)), it was assumed that the application was to be filed pursuant to 35 U.S.C. 371,

New U.S. Patent Application of Akitoshi KOJIMA
Serial No.: 09/856,393
Docket: P-0105 S

as a National Phase of the PCT application. The person in charge of filing these materials in the U.S. read "continuation application" in the same "REMARK no. (1)" to be just the foreign associate's approximate way of indicating "National Phase application," which would "continue" the prosecution of the PCT application as the next, or national, stage in the U.S. of the original PCT application.

(7) We filed this application in the U.S. Patent Office on May 22, 2001, under 35 U.S.C. 371, as a National Phase of the original PCT filing, PCT/JP99/05257, and duly reported it to our client, with copies of the documents filed.

(8) By fax letter of June 13, 2001, our Japanese associate questioned our entry on the PCT transmittal letter (Form PTO-1390) stating that an English translation of the international application had been filed. Our associate indicated that the English language document was not, in fact, an English translation of the PCT application, but a specification for a continuation application based on the PCT application. Attached is a copy of our associate's June 13, 2001 fax letter.

(9) This was the first time that applicant's U.S. attorney became aware of the inadvertent error that had been made and that applicant had requested that the application be filed as a true continuation application under 35 U.S.C. §§120, 363, and that the specification and claims were not translations of the International PCT application.

(10) Applicant's U.S. attorneys thereupon sought to convert the application to a Rule 53(b) continuation application and conducted several conferences with the PCT Legal Office. It was indicated that a Petition could be filed to effect such conversion.

New U.S. Patent Application of Akitoshi KOJIMA
Serial No.: 09/856,393
Docket: P-0105 S

(11) In these circumstances, and in view of applicant's continuing desire to file this national application as a continuation application, it is respectfully requested that this Petition be considered under Rules 181, 182 and 183.

(12) Please charge the Petition fee set forth in 37 CFR §1.174(h) of \$130.00 to our account no. 10-0100.

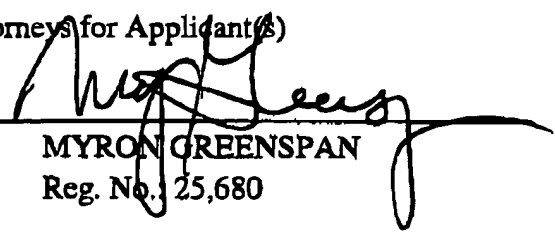
A Declaration by Adrienne Shirley is attached hereto in support of the facts stated herein.

Dated: June 29, 2001

Respectfully submitted,

Lackebach Siegel Marzullo
One Chase Road
Scarsdale, NY 10583
Telephone: 914 723 4300
MG/as

LACKENBACH SIEGEL
Attorneys for Applicant(s)

By: 
MYRON GREENSPAN
Reg. No. 25,680

Certificate of Deposit by Facsimile

I hereby certify that this correspondence is being filed by sending same by facsimile to the Petitions Branch, U.S. Patent Office, Washington, D.C. 20231, at facsimile number 703 308 6459, on the following date:

Myron Greenspan

Attorney

Signature

June 29, 2001

Date

Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted. COSTS FOR SUCH EXTENSION(S) AND/OR ANY OTHER FEE DUE WITH THIS FEE DUE WITH THIS PAPER THAT ARE NOT FULLY COVERED BY AN ENCLOSED CHECK MAY BE CHARGED TO DEPOSIT ACCOUNT #10-0100.

SUZUYE & SUZUYE

Kasumigaseki UBE Bldg., 3-7-2 Kasumigaseki, Chiyoda-ku, Tokyo 100-0013, Japan

Facsimile +813-3501-5663 / +813-3501-5672 : Telephones: +813-3502-3181 / +813-3502-3186(Direct)

Dated May 18, 2001 Our Ref. 2SK-99S0755P1

Lackenbach Siegel Marzullo Aronson & Greenspan, P.C.

Lackenbach Siegel Building, One Chase Road, Scarsdale, N.Y. 10583, U. S. A. Tel. 914-723-4300

Gentlemen:

Please file an application in accordance with the following particulars. As soon as you receive this case, please acknowledge receipt, most desirably by faxing the attached sheet (Fax: +813-3501-5663 or -3501-5672) with a suitable acknowledgment thereon, along with your docket number. Please acknowledge by fax on **THE DAY OF RECEIPT** of these instructions.

CONTINUATION APPLICATION IN THE UNITED STATES

based on INTERNATIONAL APPLICATION (filed in Japan) No. PCT/JP99/05257, filed September 27, 1999

TITLE: PRONUNCIATION JUDGEMENT SYSTEM**ASSIGNEE:**

KOJIMA CO., LTD., a Japanese corporation, located at 1-8, Hoshigaoka 2-chome, Utsunomiya-shi, Tochigi 320-8528 Japan

INVENTOR: (Nationality/citizenship is given in the parentheses)

Mailing and Residence Address(es)

Akitoshi Kojima, of c/o KOJIMA CO., LTD., 1-8, Hoshigaoka 2-chome, Utsunomiya-shi, Tochigi 320-8528 Japan (Japan)

A LIST OF BASIC APPLICATIONS: (Please claim priority from the applications marked 'Yes' below.)

Country	Category	Application No.	Filing date	Priority Claim
(N O N E)				

A LIST OF DOCUMENTS ([X] - Enclosed [] - To follow [/] - Irrelevant item to be disregarded)

<input checked="" type="checkbox"/> Specification & claims	<input checked="" type="checkbox"/> Formal drawings	<input checked="" type="checkbox"/> Informal drawings
<input checked="" type="checkbox"/> Declaration & power of attorney	<input checked="" type="checkbox"/> Inventors' Assignment/consent	<input checked="" type="checkbox"/> Priority document(s)
<input checked="" type="checkbox"/> Information Disclosure Statement(s) (see (8) below)	<input checked="" type="checkbox"/> Copy of int'l search report/cited art (see (8) below)	
<input checked="" type="checkbox"/> First page of Intern'l Publication		

SPECIFIC REMARKS:

- (1) Please file a Rule 53(b) continuation application on the basis of the above-identified PCT application definitely on or before May 25, 2001 (Friday) (20 months from the priority date), and in any event [if Saturday is your official holiday], the first working day of May 27, 2001.
The parent(PCT) application **SHOULD** be abandoned.
- (2) Inventorship remains unchanged.
- (3) This PCT application was filed and ~~was~~ **will be** published in the Japanese language.
- (4) No amendments have been made under PCT Article 19 and Article 34.
- (5) The International Search Report has already been issued by the JPO.
- (6) ~~Please do not file a Rule 1.212 nonpublication request. The invention has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement.~~
- (7) The name of the city and country where each inventor resides is marked in purple above.
- (8) If a copy of the int'l search report/cited art or prior art reference(s) is enclosed, please prepare and file an IDS.
- (9) When the declaration is not enclosed, please indicate in the petition the residence of each inventor, and No. and filing date of each basic application, so that they appear in the official filing receipt.
- (10) When the error-carrying official filing receipt is received, please do NOT automatically apply for corrections, but merely put this to our attention.
- (11) If you need to reach us outside normal working hours, you may call (Mr) Hideo Nakamori at home at 81-47-372-6154.
(A telefax may also be sent to him by dialing the same number without a warning phone call.)
- (12) Upcoming Holidays (Suzuye closed): none within about two-week time

SUZUYE & SUZUYE

PATENT & LAW FIRM SINCE 1910

Kasumigaoka, UBE Bldg. 3-7-2 Kasumigaoka, Chiyoda-ku, Tokyo 100-0013, Japan

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Fax from: +81-3-3501-5663

Confirmation by Mail: YES

Your ref. P-0105 S

Our ref. 2SK-99S0755P1

TAKASHI SUZUYE
(代表者)

TAKESHI SUZUYE

KOHEI SUZUYE

SHOU NURAMATSU

TAKESHI HASHIMOTO

TAKESHI KOIKE

AJIRA KUNIO

NAKOTO NAKAMURA

MASATOSHI KURATA

TAKESHI MIKE

TAKESHI KAWAII

TAKESHI SUZUYE

YUKO KATSUYA

MABURU NUKAWA

ATSUSHI ISHIBUI

TAKESHI ISHIKAWA

TAKESHI SUZUYE

AKIYOSHI NAKAMURA

KENSUKE MORIMOTO

RYUTARO KOGA

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HIROSHI KATSUYAMA

HIROO YOSHINO

MASANOSU TANAKA

HIROHARU SAITO

MASAKO NISHIMURA

ATSUSHI MATSUMI

SHIGEYOSHI HATA

HIROSHI SUGA

TAKESHI OKADA

SARAF MIYANAGA

YUKO KAWA

HIROKO NAKAMURA

**REPLY BY FAX

* Confirming People

Is a document

Ms. Adrienne Shirley
 Lackenbach Siegel Marzullo
 Aronson & Greenspan, P.C.
 Lackenbach Siegel Building,
 One Chase Road,
 Scarsdale, N.Y. 10583,
 U. S. A.

June 13, 2001

U.S. Patent Application No. 09/856,393
Akitoshi KOJIMA (KOJIMA CO., LTD.)

Dear Ms. Shirley:

We have noticed that the Petition filed in this case is titled "PCT Patent Application (national phase)" and a box for "An English translations of the International Application" is checked.

What we sent to you with our filing instruction is NOT an English translation of the PCT application, but a specification for a continuation application based on the PCT application.

Please urgently check your record and file and see that everything is in order.

Your reply by return facsimile is requested.

Very truly yours,

SUZUYE & SUZUYE



International Administration Div.

HN/yo

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the New U.S. Patent Application of

Akitoshi KOJIMA

Examiner:

Serial No.: 09/856,393

Art Unit:

Filed: May 22, 2001

Docket: P-0105 S

For: Pronunciation Judgment System

HAND DELIVERED TO:

Commissioner of Patents: Attn - Petitions Branch
Washington, D.C. 20231

DECLARATION OF ADRIENNE SHIRLEY
IN SUPPORT OF PETITION CONVERT STATUS OF PATENT APPLICATION

SIR:

I, Adrienne Shirley, do declare:

1. I am employed by the law firm of Lackenbach Siegel as a Paralegal / Assistant, and have been so employed for eight years.
2. I have been accustomed to process new applications for filing in the U.S. Patent Office since I began work here in January 1993.
3. On or around May 21, 2001, I received a package from one of our associate firms in Japan. The associate firm requested that we file the application by May 25, 2001.

New U.S. Patent Application of Akitoshi KOJIMA
Serial No.: 09/856,393
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3. This Japanese associate had sent many applications to our firm for filing. We were given priority materials either in the form of copies of or reference to a Japanese national application, or in the form of copies of documents previously filed in a PCT application based on a Japanese national application.

4. With Japanese national filing priority cases, we were asked to file a U.S. national application deriving priority from the Japanese application. In the second case, we were asked to file a National Phase application in the U.S. based on the PCT patent application.

5. When I received the filing materials for the above-captioned U.S. filing, I noted that the packet contained copies of documents previously filed in the PCT, as well a translation of a filing in Japanese into the English language. I considered this English translation to be "A English-language translation of the International Application," and checked the appropriate box on Form 1390 (PCT Chapter II filing).

6. The cover letter received from our Japanese associate identified the enclosures as specification and claims," "formal drawings," "informal drawings," "Declaration & power of attorney," "Inventors' Assignment/consent," and a "Copy of int'l search report/cited art" as well as a "First page of Intern'l Publication."

7. On the basis of the prior filings I had processed for our Japanese associates, and on the basis of this associate's instructions that the application be filed "on the basis of the above-identified PCT application," I assumed that the application was to be filed pursuant to 35 U.S.C. 371, as a

New U.S. Patent Application of Akitoshi KOJIMA
Serial No.: 09/856,393
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National Phase of the PCT application, and processed it accordingly. I read the associate's phrase "continuation application" to mean just an approximate way of indicating a "PCT National Phase application," which would "continue" the prosecution of the PCT application as the next, or national, stage in the U.S.

8. Our firm filed this application in the U.S. Patent Office on May 22, 2001, under 35 U.S.C. 371, as a National Phase of the original PCT filing, PCT/JP99/05257, and it was duly reported to our client, with copies of the documents filed.

9. On June 13, 2001, our Japanese associate faxed us a letter questioning our statement on the PCT transmittal letter (Form PTO-1390) that an English translation of the international application was attached to our filing. The associate indicated that this English-language document was not a translation of the PCT application, but rather an English-language specification for a continuation application based on the PCT application.

10. This was the first time that I or, to my information and believe, that anyone in this firm became aware that an inadvertent error had been made, and that the applicant had requested that the application be filed as a true continuation application under 35 U.S.C. §§120, 363, and that the specification and claims were not translations of the International PCT application.

11. My supervising attorney in this matter then attempted to convert the application to a Rule 53(b) continuation application and conducted several conferences with the PCT Legal Office. It was indicated that a Petition could be filed to effect such conversion.

New U.S. Patent Application of Akitoshi KOJIMA
Serial No.: 09/856,393
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12. In view of applicant's continuing desire to file this national application as a continuation application, we have submitted this Petition for consideration under Rules 181, 182 and 183.

I, Adrienne Shirley, hereby state that all statement made herein of my own knowledge are true and that all statement made on information and believe are believed to be true.

Dated: June 29, 2001

Adrienne Shirley
Adrienne Shirley

MODE = MEMORY TRANSMISSION

START=JUN-29 15:04

END=JUN-29 15:07

FILE NO. = 207

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-LACKENBACH SIEGEL -

*****-914 723 4301 - ***** 914 723 4301- *****

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the New U.S. Patent Application of

Akitoshi KOJIMA

Examiner:

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Washington, D.C. 20231PETITION UNDER 37 CFR §§1.181, 1.182 AND 1.183
WITH SUPPORTING DECLARATION

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The facts in support of this Petition are as follows:

(1) The application was received from an associate firm in Japan on May 21, 2001. The